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**JUL 05 2005**

**OFFICE OF PETITIONS**

In re Application of :  
Miller et al. :  
Application No. 09/757,202. : DECISION ON APPLICATION  
Filed: January 9, 2001 : FOR  
Atty Docket No. GC-10.6-CON : PATENT TERM ADJUSTMENT  
: :

This is a decision on the "Application under 37 CFR 1.705(b) For Patent Term Adjustment," filed February 17, 2005. Applicants request that the above-identified application be credited with 202 days of patent term adjustment. This request is based in part on the Office taking in excess of three years to issue the patent.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years (and for failure to issue the patent within four months of payment of the issue fee and satisfaction of all outstanding requirements). See § 1.703(b).

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent

within 3 years. A copy of this decision should accompany the request. Patentees may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one hundred sixty-one (161) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 30, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 0 days (including 2 periods of reduction of 60 and 325 days). Applicants timely filed the instant application for patent term adjustment<sup>1</sup>. Applicants dispute the reduction of 325 days. Furthermore, applicants assert entitlement to a period of adjustment of 262 days. Applicants assert that their response to the non-final Office action mailed February 7, 2002, was faxed to the Office within three months on May 6, 2002, not March 28, 2003. Thus, no period of reduction should have been entered. Further, given the date of receipt of May 6, 2002, applicants assert entitlement to an adjustment under § 1.703(a)(2) for Office delay. Specifically, applicants request a period of adjustment of 262 days for the delay in mailing a non-final Office action until May 28, 2003.

Applicants state that the patent issuing from the application is subject to a terminal disclaimer. Applicants state that both patents over which this application has been terminally disclaimed would expire later than the term of the instant application.

A review of the application history reveals that no response to the Office action mailed February 7, 2002 was considered timely

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<sup>1</sup> Office records show that the Issue Fee payment was received on February 23, 2004.

filed by the Office and the application became abandoned. Applicants were advised of the abandonment by notice mailed October 1, 2002. The record establishes that, in response, on October 8, 2002, applicants filed a petition to withdraw the holding of abandonment. It is specifically noted that the petition to withdraw the holding of abandonment was filed within two months from the mailing date of a notice of abandonment. See § 1.704(c)(4). Moreover, by decision mailed March 28, 2003, the petition was granted on the basis that applicants had shown that a proper response was filed on May 6, 2002.

In view thereof, it is concluded that applicants did not fail to engage in reasonable efforts to conclude processing or examination of the application by delaying in replying to the Office action within the meaning of § 1.704(b).

Moreover, applicants are correct that given the showing of receipt of applicants' response in the Office on May 6, 2002, the application is entitled to a period of adjustment for Office delay. The Office did not take action in response until May 28, 2003. Pursuant to § 1.702(a)(2) and § 1.703(a)(2), the period of adjustment is 264 (not 262) days, counting the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed, September 7, 2002, and ending on the date of mailing of an action under 35 U.S.C. 132, May 28, 2003.

However, a review of the record also reveals further basis for reduction: Pursuant to 37 CFR § 1.704(c)(8), the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage in reasonable efforts to conclude prosecution. It has been established that on May 6, 2002, applicants filed a response. Then, on June 18, 2002, applicants filed an Information Disclosure Statement (IDS). The record does not support a conclusion that this IDS was expressly requested by the examiner. Nor is the IDS accompanied by a § 1.704(d) statement. Accordingly, the PTA will be reduced by 43 days, the number of days beginning on the day after the date the initial reply was filed, November 7, 2002, and ending on the date that the supplemental reply or other such paper was filed, June 18, 2002 for the filing of the IDS.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is one hundred sixty-one (161) days (243 - (60 + 43)).

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

*Karin Ferriter  
JFC*

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Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

Enclosure: Copy of REVISED PAIR Screen